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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,547	07/29/2003	Mark T. Marshall	P-11313.01	7482
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MEDTRONIC, INC. 710 MEDTRONIC PARKWAY NE MINNEAPOLIS, MN 55432-9924			FLORY, CHRISTOPHER A	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/630,547	MARSHALL ET AL.
	<b>Examiner</b> CHRISTOPHER A. FLORY	<b>Art Unit</b> 3762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 02 June 2006.  
 2a) This action is FINAL.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1,2 and 7-48 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1,2 and 7-48 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 02 June 2006 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date: _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/06/08) Paper No(s)/Mail Date: _____	6) <input type="checkbox"/> Other: _____

**DETAILED ACTION**

***Drawings***

1. The drawings were received on 2 June 2006. These drawings are acceptable.

***Response to Arguments***

2. Applicant's arguments with respect to claims 1, 2 and 7-48 have been considered but are moot in view of the new ground(s) of rejection.

***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. It is noted that since the last Action on the instant application, copending Application No. 10/439,201 has issued as Patent US 7,191,016. Therefore, claims 1, 2 and 7-48 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10, 14-18, 22, and 25-27 of U.S. Patent No. 7,191,016. Although the conflicting claims are not identical, they are not patentably distinct from each other because the component of a second elongated lead body in independent claims 1 and 20, and dependent claim 44 of the instant application does not distinguish over the device embodied in the independent claim of the '016 patent because it shares a common functionality, and a device with a first and second lead bodies is a reasonable embodiment thereof. It is well known in the field that medical lead electrodes can be placed either adjacent to each other on one lead body when intended for placement within the same chamber (e.g. the right ventricle) or placed each on its own lead body for the sake of placement across different barriers of the heart

(e.g. one in the right ventricle and the other in a cardiac vein), both embodiments being for the purpose of pacing/sensing in a localized region of the heart.

***Claim Rejections - 35 USC § 102/103***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 2, 7-10, 16-18, 20-29 and 35-47 are rejected under 35 U.S.C. 102(b) as anticipated by Carson (US Patent Number 5,931,862, hereinafter Carson'862) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Carson'862 in view of Houser et al. (US 6,361,559, hereinafter Houser'559).

Regarding claims 1-2, 20, 21, 43, 44 and 47, Carson'862 shows a medical electrical lead (Fig. 1, lead 12) comprising an elongated body with a first elongated insulated conductor, a second elongated insulated conductor (column 4, lines 52-63) and a connector with a first and second electrical contact formed at a proximal end (connectors 22 and 24); a first low voltage electrode adapted for intimate contact with tissue to provide pacing stimulation (Figs. 2 & 3, distal pacing electrode 20, helical coil or tined formations); a second low voltage electrode joined to the lead body in proximity to the first electrode (underlying electrode 16); and a porous layer formed over the second electrode (porous tubular covering 10); wherein the outer surface of the second electrode (16) is recessed from the outer surface of the lead body (Fig. 2) and the outer

surface of the porous layer (10) is isodiametric with the outer surface of the lead body (column 2, lines 39-44).

Further regarding claim 1, Carson'862 discloses that the layer 10 covering the electrodes may be impregnated with collagen via perfusion, which is taken to reasonably disclose a sheet of collagen fibers, since the ePTFE sheet will be evenly distributed with the perfused collagen fibers (column 8, lines 50-65). Alternatively, in the same field of endeavor, Houser'559 teaches covering electrodes with a porous material, such as collagen, to further define a structure for tissue to shrink and coagulate, to encourage neointimal cell growth, and to enhance thermal bonding between the device structure and vessel wall (column 23, line 60 through column 24, line 25). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Carson'862 with the collagen layer covering the electrode structures as taught by Houser'559 to provide Carson'862 with the same advantages.

Further regarding claims 20 and 21, Carson '682 discloses that the porous layer is adapted to prevent chronic tissue ingrowth (column 2, lines 47-48). The prevention of chronic tissue ingrowth, which prevents the electrode from coming in direct contact with the tissue, is a sufficient and effective means of preventing the electrode from stimulating tissue in proximity to the electrode. Alternatively, the pulse generator (Fig. 1, generator 11) of Carson'862 must inherently contain a control means used in the art, such as a microprocessor. That control means provides a means for preventing the second electrode from stimulating the tissue as the alternate state to control-driven stimulation of tissue. If the device is off, or the second electrode channel is powered

down or in a blanked state, the control means is preventing the second electrode from delivering stimulation to the tissue.

Regarding claims 7-10 and 26-29, Carson'862 discloses a means to promote wetting comprising a wetting agent which can be a surfactant and a surface treatment of the porous layer (column 2, line 54 through column 3, line 26).

Regarding claims 16 and 35, Carson'682 discloses the invention as previously recited wherein the porous layer is adapted to prevent chronic tissue ingrowth (column 2, lines 47-48).

It is noted that the component of a second elongated lead body in the instant application does not distinguish over the device of Carson'682 because it shares a common functionality, and a device with a first and second lead bodies is a reasonable embodiment of the Carson'682 system, where connector branches 22 and 24 with porous coverings 10' and 10" could extend for the full length of the device and in such a configuration constitute a first and second lead body, each containing one of the pacing/sensing electrodes and capable of being implanted in the cardiac vein or the right ventricle (as shown in Figure 1).

Regarding claims 22-25, Carson'862 discloses that the porous layer may comprise silicone, polyurethane, expanded PTFE, or collagen (column 2, lines 39-53; column 5, lines 10-23).

Regarding claim 36, bipolar or near-field sensing are well known in the cardiac pacing art, and therefore do not distinguish over the combination of Carson'862 in view

of Houser'559. Additionally, Houser'559 teaches bipolar sensing (column 15, line 65 through column 16, line 16).

Regarding claims 37-39, Carson'862 discloses the invention substantially as claimed including spaced electrode pairs, but does not expressly disclose the range between 2-9 mm. It would have been obvious to one having ordinary skill in the art at the time of the invention to use a spacing of 2-9mm, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges (*In re Aller*, 105 USPQ 233) or optimum value of a result effective variable (*In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980)) involves only routine skill in the art.

Regarding claims 40 and 42, any of electrodes 16 and 20 (Fig. 2); 20, 38, 42, and 44 (Fig. 3) are capable of functioning as the anode or cathode such that the cathode electrode assembly could be positioned distal to the anode electrode assembly, or such that the anode could be positioned distal to the cathode.

Regarding claim 41, Carson'862 shows a fixation helix (Fig. 1, helix 20).

Further regarding claim 44, and regarding claims 17, 18, 45 and 46, Carson'862 shows the lead body placed in a cardiac vein, passing through an atrium, and within the right ventricular chamber (Figs. 1 and 2).

#### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3762

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 11-14, 30-33 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carson'862 or Carson'862 in view of Houser'559 as applied to claim 1 above, and further in view of Hull et al. (US Patent 5,269,810, hereinafter Hull'810).

Carson'862 shows the invention substantially as claimed, but does not disclose the thickness of the porous layer (2-9 mm) or the desired size range for the pores in that layer (0.4-50 microns).

In the same problem solving area, Hull'810 teaches an electrode-covering layer that is about 0.13 mm (0.005 inches) thick with fibril length (i.e. intermodal distance and pore size) of 10 microns for the advantages of being highly biocompatible, highly flexible, and long-lasting (column 3, lines 32-45; column 4, lines 1-15).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use similar structural criteria with the Carson'862 invention for the same advantages of biocompatibility, flexibility and long lifespan (motivation to combine provided by Hull et al., column 3, lines 32-45; column 4, lines 1-15).

9. Claims 12-15, 31-34 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carson'862 or Carson'862 in view of Hauser'559 as applied to claim 1 above, and further in view of Soukup et al. (US Patent 5,466,252).

Carson'862 shows the invention substantially as claimed, but does not disclose the desired size range for the pores in that layer (0.4-50 microns).

In the same field of endeavor, Soukup et al. teaches an implantable lead with a porous PTFE layer with preferred fibril lengths greater than 4 microns, and most preferably greater than 10 microns to provide the necessary amount of flexibility and extensibility for the intended application and to present an acceptable biocompatible surface to the blood chemistry to which the outer surface of the lead will be exposed (column 2, lines 26-34).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use similar parameters for the lead body covering in the Carson'862 invention to provide the same advantages of flexibility and biocompatibility (motivation to combine provided by Soukup et al., column 2, lines 26-34).

10. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Carson'862 or Carson'862 in view of Houser'559 as applied to claim 1 above, and further in view of Kroll (US Patent 6,327,498).

Carson'862 shows the invention substantially as claimed, but does not disclose a third high voltage electrode adapted for defibrillation stimulation.

In the same field of endeavor, Kroll'498 teaches a third electrode (Fig. 2, electrode 46) placed proximal to a second electrode (32) and distal to a first electrode (34) for the purpose of providing shocking stimulation pulses (column 7, lines 64-67).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include a third electrode in the Carson'862 device for the same advantage of applying shocking stimulation (defibrillation) to the heart (motivation to combine provided by Kroll'498 column 7, lines 64-67).

11. Claims 1, 2, 7-10, 11, 16, 20-30 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krall et al. (WO 02/089909 A1) in view of Houser'559.

Regarding claims 1-2, 20 and 21, Krall et al. shows a medical electrical lead (Fig. 1, lead body 6) comprising an elongated body with a first elongated insulated conductor, a second elongated insulated conductor (Fig. 2 coiled electrical conductor 14, second electrical conductor 16) and a connector with a first and second electrical contact formed at a proximal end (connectors 4); a first low voltage electrode adapted for intimate contact with tissue to provide pacing stimulation (Fig. 2, distal tip electrode 10); a second low voltage electrode joined to the lead body in proximity to the first electrode (coiled electrode portion 8, coiled electrode 24); and a porous layer formed over the second electrode (porous thin film 30); wherein the outer surface of the second electrode (24) is recessed from the outer surface of the lead body (Fig. 2) and the outer surface of the porous layer (30) is isodiametric with the outer surface of the lead body (column 2, lines 39-44).

Further regarding claim 1, Krall et al. discloses the invention substantially as claimed, but does not expressly disclose that the layer covering the electrode comprises silicone or a sheet of collagen fibers. In the same field of endeavor, Houser'559 teaches covering electrodes with a porous material, such as collagen, to further define a structure for tissue to shrink and coagulate, to encourage neointimal cell growth, and to enhance thermal bonding between the device structure and vessel wall (column 23, line 60 through column 24, line 25). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Krall et al.

with the collagen layer covering the electrode structures as taught by Houser'559 to provide Carson'862 with the same advantages.

Regarding claims 7-10,11, 16, 22-30 and 35, Krall et al. discloses that the cover comprises a porous polymer (claim 1), preferably ePTFE (claim 8); is relatively thin, on the order of .13mm (or .005inches) thick (page 3, lines 5-6; page 10, lines 26 through page 11, line 4); is adapted to prevent chronic tissue ingrowth (page 3, lines 10-13); and comprises a means of wetting (claims 13-14, surfactant polyvinyl alcohol).

It is noted that the component of a second elongated lead body in the instant application does not distinguish over the device of Krall et al. because it shares a common functionality, and a device with a first and second lead bodies is a reasonable embodiment of the Krall et al. system, where connectors (4) could extend for the full length of lead assembly (2) and in such a configuration constitute a first and second lead body, each containing one of the pacing/sensing electrodes and capable of being implanted in the cardiac vein or the right ventricle (as shown in Figure 1).

12. Claims 1, 2, 16-24 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Belden (US Patent 6,847,845, hereinafter Belden'845) in view of Houser'559.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in

the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding claims 1, 2, 16-24 and 35, Belden'845 discloses a medical system comprising an implantable medical device (80); a first elongated lead body (10) implanted in a cardiac vein with a first electrode (12) adapted for intimate contact with tissue and a second electrode (16) with a porous layer (32) formed over the second electrode which may be isodiametric and comprised of ePTFE, silicone, or polyurethane (column 3, lines 20-25, 47-56) and adapted to prevent chronic tissue ingrowth (column 3, line 64 through column 4, line 5); a second elongated lead body (70) implanted in the right ventricle (column 5, lines 54-67) with a second electrode (72); and comprising a third high voltage electrode adapted for defibrillation stimulation (defibrillation coil 74).

Further regarding claim 1, Belden'845 discloses the invention substantially as claimed, but does not expressly disclose that the layer covering the electrode comprises silicone or a sheet of collagen fibers. In the same field of endeavor, Houser'559 teaches covering electrodes with a porous material, such as collagen, to further define a structure for tissue to shrink and coagulate, to encourage neointimal cell growth, and to enhance thermal bonding between the device structure and vessel wall (column 23, line 60 through column 24, line 25). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Belden'845 with the collagen layer covering the electrode structures as taught by Houser'559 to provide Carson'862 with the same advantages.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher A. Flory whose telephone number is (571) 272-6820. The examiner can normally be reached on M - F 8:30 a.m. to 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on (571) 272-4955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher A. Flory  
27 February 2008

**/George Manuel/**  
Primary Examiner